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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,361

04/04/2005

David A Jarus

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35227 7590 04/10/2009  
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EXAMINER

MULLIS, JEFFREY C

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

04/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/530,361	<b>Applicant(s)</b> JARUS ET AL.	
	<b>Examiner</b> Jeffrey C. Mullis	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 depends from canceled claim 2 and is therefore unclear.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

. Claims 1, 3 and 5-9 are rejected under 35 U.S.C. 103(a) as obvious over Abdou-Sabet (US 6,100,334).

Patentees disclose a combination which may contain ethylene alpha olefin compatibilizers (column 6, lines 50-55) at a level of 2 or 5 percent in combination with polyolefin and rubbery compound (column 3, lines 49-60), oil (column 4, lines 45 and wherein the rubbery compound may be EPDM (paragraph bridging columns 2 and 3).

There are no specific examples having all of applicants materials in combination. However, to arrive at such by selecting from the various disclosures of the reference would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected or surprising results.

Claims 1, 3, 5 and 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by McBride (US 7,196,137).

Patentees disclose a dynamically vulcanized blend of PP, EPDM, oil, and as little as 5% SBC (column 2, lines 1-5 and patent claim 4).

Claims 1, 3, 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacob (US 7,319,121).

Patentees disclose a dynamically vulcanized composition of thermoplastic polyolefin such as polypropylene , EPDM, SBC and oil. See patent claims 3, 4, 7, 15 and 16.

There are no specific examples having all of applicants materials in combination. However, to arrive at such by selecting from the various disclosures of the reference would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected or surprising results.

Applicant's arguments filed 2-3-09 have been fully considered but they are not persuasive.

It is not the position of the examiner that Abdou-Sabet provides any examples of applicants composition and thus anticipates the claims. Patentees however do disclose in their specification however that "rubbery polymers" (distinguished from compatibilizers by patentees) include those produced from "one or more" monomers including ethylene and propylene and also diene monomers at column 3, lines 18-25. Such a polymer reasonably is encompassed by the term "EPDM" as is used in the art and therefore it is immaterial that the claims recite "consisting essentially of" in that even the term "consisting of" would encompass any material reasonably viewed in the art as EPDM which is not necessarily viewed as limited to terpolymers. In any case the term "consisting essentially of" only excludes those materials which materially affect the novel and basic characteristics of a composition and it is applicants' burden to prove that such characteristics are changed by the presence of additional materials recited in a prior art product. Note In re Janakirama-Rao, 317 F. 2d 951, 137 USPQ 893 (CCPA 1963) and In re De Lajarte, 337 F. 2d 870, 143 USPQ 256 (CCPA 1964) in this regard.

Patentees use applicants amounts of compatibilizers at column 3, line 60. It is true that G49 exhibited no compatibilization as was admitted by Sabet. Nonetheless Sabet discloses that SBC's are "potential compatibilizer(s)". Comparative example F and example 5 exhibit only a minor change in domain size and it is not clear if this would have resulted in a conclusion of compatibility by patentees or not. With regard to comparative example G and example 10 it can not be ascertained if only features

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present in the claims are responsible for the large change in domain size since more than 1 feature is varied from the prior art. Furthermore all runs in patentees Table IV exhibit compatibilization including those using SBC when ZnO/tin chloride and phenolic resin are present and those skilled in the art would assume that SBC would function as a compatibilizer at least when these materials are present. It is noted that applicants own claims recite vulcanization and therefore curatives as for instance phenolics cannot be said to be excluded by consisting essentially of. In any case none of applicants claims require SBC. With regard to applicants particle size analysis, no data comparative to Sabet is of record but in any case, it is known in the art that compatibilization decreases domain size and therefore decrease in domain size upon addition of the compatibilizers of patentees would not be unexpected.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis  
M-F, 9-5pm at telephone number 571 272 1075.

Jeffrey C. Mullis  
Primary Examiner  
Art Unit 1796

JCM

4-7-09

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/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1796